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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,828	11/04/2003	Dan Kikinis	P1503D2	7049
24739 7590 02/08/2008 CENTRAL COAST PATENT AGENCY, INC 3 HANGAR WAY SUITE D WATSONVILLE, CA 95076			EXAMINER ELAHEE, MD S	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 02/08/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/701,828

Applicant(s)

KIKINIS, DAN

Examiner

Md S. Elahee

Art Unit

2614.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/04/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 17-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U. S. 6,483,905. Because claim in the pending application is broader than the one in patent, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the patent incorporates the limitations of claim 17 in the pending application.

3. Claims 17-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U. S. 6,973,167. Because claim in the pending application is broader than the one in patent, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claims 1, 9 and 13 of the patent incorporates the limitations of claims 17, 25 and 29 in the pending application respectively.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “/” in claim 29, line 10 is used by the claim to mean “and”, while the accepted meaning is “either ‘and’ or ‘or’”. The term is indefinite because the specification does not clearly redefine the term.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 17-24 are rejected under 35 U.S.C. 102(e) as being anticipated by **Lemaire et al.** (U.S. 5,444,768).

Regarding claim 17, with respect to Figures 1A and 2, **Lemaire** teaches an electronic document answering machine comprising:

an interconnected CPU 40, memory 15,54-58, and modem 42 with a telephone connection (col.8, lines 18-22);

**Lemaire** further teaches a system for communicating stored documents to a user (fig.2; labels 13 and 20; col.7, lines 6-21, col.9, lines 18-31),

**Lemaire** further teaches an alert for signaling a user that new documents are waiting to be reviewed (col.7, lines 6-21);

**Lemaire** further teaches an input for a user to signal the system to communicate the new documents to the user (col.5, lines 36-66), and

**Lemaire** further teaches a digital communication link for connecting to a host personal computer (PC), wherein the electronic document answering machine periodically connects to remote sources, receives and stores digital documents, and activates the alert apparatus as new documents are stored, and wherein, in response to the input, the electronic document answering machine communicates stored documents one-at-a-time to the user, and whereto the electronic document answering machine is adapted to communicate stored documents to the PC for processing (fig. 4-5, fig.6, label 134,146; col.6, lines 55-65, col.14, lines 3-24).

Regarding claim 18, **Lemaire** teaches the electric document answering machine of claim 17 wherein the system for communicating stored documents comprises a speaker and voice synthesis apparatus (fig.4).

Regarding claim 19, **Lemaire** teaches the electronic document answering machine of claim 17 wherein the system for communicating stored documents comprises a display apparatus (col.9, lines 64-68).

Regarding claim 20, **Lemaire** teaches the electronic document answering machine of claim 17 adapted for use by the PC as a modem (fig.6, label 130).

Regarding claim 21, **Lemaire** teaches the electronic document answering machine of claim 17 wherein the modem is operated by the CPU and has no separate CPU (fig.6, label 130).

Regarding claim 22, **Lemaire** teaches the electronic document answering machine as in claim 17 wherein the remote sources include an Internet mail server, and downloaded documents include e-mail addressed to a particular user (col.2, lines 40-45, col.3, lines 42-46, 60-63).

Regarding claim 23, **Lemaire** teaches the electronic document answering machine of claim 17 wherein the alert apparatus is an LED and the input is a pushbutton having the LED integrated in the pushbutton (fig.1A, labels 38,33).

Regarding claim 24, **Lemaire** teaches the electronic document answering machine of claim 23 further comprising a second pushbutton adapted for applying and removing power to power-using elements (fig.1A, labels 30,32,34 or 36).

8. Claim 29 is rejected under 35 U.S.C. 102(e) as being anticipated by **Perlman et al.** (U.S. 5,896,444).

Regarding claim 29, with respect to Figures 1-3, **Perlman** teaches an electronic document answering machine for use with a TV set, comprising:

an interconnected CPU 21, memory 22,23, and modem 27,30 (fig. 2B);

**Perlman** further teaches led [i.e., an alert] for signaling a user that new documents are waiting to be reviewed (col.7, line 63-col.8, line 11);

**Perlman** further teaches at least one of an audio and a video output port (fig. 2B, labels 25, 26); and

**Perlman** further teaches an infra-red port for receiving infra-red signals from a remote controller (fig.2A, label 24);

**Perlman** further teaches wherein the CPU, executing stored control code, periodically connects to remote sources, and downloads and stores digital documents, and activates the alert apparatus as new documents are stored, and wherein the CPU in response to input from a user via the infra-red port, communicates stored documents one-at-a-time to a TV set via the audio/video output port (col.4, lines 16-20, col.7, line 63-col.8, line 11).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lemaire et al.** (U.S. 5,444,768) in view of **Clark et al.** (U.S. 5,666,530).

Regarding claim 25, with respect to Figures 1A and 2, **Lemaire** teaches an electronic document answering machine in a personal computer (PC), comprising:

a retriever for periodically accessing remote resources and retrieving and storing digital documents (fig. 4-5, fig.6, label 134,146; col.6, lines 55-65, col.14, lines 3-24);

**Lemaire** further teaches an LED alert apparatus for signaling a user that one or more new documents have been retrieved and stored and are ready for review (fig.1A, labels 38,33; col.7, lines 6-21); and

**Lemaire** further teaches an initializing input pushbutton having the LED integrated in the pushbutton, for a user to signal the system to communicate the stored documents one-at-a-time for review by the user (fig.1A, labels 38,33; col.5, lines 36-66),

However, **Lemaire** does not teach the following limitations:

“wherein the system is adapted to operate using CPU and memory elements of the PC with special operating code provided for the system, and to operate during periods of time the PC is in reduced-power power as well as when the PC is in fur operating mode”

**Clark** teaches a computer which operates in full and power down capabilities (col.5, lines 24-37 and 65-col.6, line 15). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add power-down capabilities to **Lemaire**’s invention for providing reduced power consumption as taught by **Clark**’s invention in order to provide flexible operation capabilities.

Regarding claim 26, **Lemaire** teaches the system of claim 25 wherein the digital documents include e-mail addressed to the PC user (col.2, lines 40-45, col.3, lines 42-46, 60-63).

Regarding claim 27, **Lemaire** teaches the system of claim 25 where the alert apparatus and the pushbutton are in a keyboard in communication with the PC.

Regarding claim 28, **Lemaire** teaches the system of claim 27 wherein the alert apparatus is an LED in a standard keyboard adapted to serve as the alert apparatus, arid the input apparatus is a standard key on the keyboard adapted to serve as the pushbutton (fig.1A, labels 38, 33).

12. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cooper et al.** (U.S. 6,052,442) in view of **Perlman et al.** (U.S. 5,896,444) further in view of **Clark et al.** (U.S. 5,666,530).

Regarding claim 25, with respect to Figures 1 and 2, **Cooper** teaches an electronic document answering machine in a personal computer (PC), comprising:

a retriever for periodically accessing remote resources and retrieving and storing digital documents (col.1, lines 20-29, col.4, lines 37-43);

**Cooper** further teaches an alert apparatus for signaling a user that one or more new documents have been retrieved and stored and are ready for review (col.4, lines 41-43, col.4, lines 59-67); and

**Cooper** further teaches an initializing input for a user to signal the system to communicate the stored documents one-at-a-time for review by the user (col.4, lines 43-47, col.7, lines 15-20),

However, **Cooper** does not teach the following limitations:

“an LED alert apparatus” and “input pushbutton having the LED integrated in the pushbutton”

**Perlman** teaches an LED alert apparatus and input pushbutton having the LED integrated in the pushbutton (fig.1A, labels 38,33; col.5, lines 36-66). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add LED indicator to **Cooper**’s invention for providing alerting as taught by **Perlman**’s invention in order to provide visual notification.

**Cooper** in view of **Perlman** further does not teach the following limitations:

“wherein the system is adapted to operate using CPU and memory elements of the PC with special operating code provided for the system, and to operate during periods of time the PC is in reduced-power power as well as when the PC is in fur operating mode”

**Clark** teaches a computer which operates in full and power down capabilities (col.5, lines 24-37 and 65-col.6, line 15). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add power-down capabilities to **Cooper's** invention in view of **Perlman's** invention for providing reduced power consumption as taught by **Clark's** invention in order to provide flexible operation capabilities.

Regarding claim 26, **Cooper** teaches the system of claim 25 wherein the digital documents include e-mail addressed to the PC user (col.8, lines 6-12).

### *Conclusion*


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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MD SHAFIUL ALAM ELAHEE  
Examiner  
Art Unit 2614  
February 2, 2008